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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/326,285	06/07/1999	JENNIE BIH-JIEN SHEN	BB-1137	4005

23906 7590 11/28/2003

E I DU PONT DE NEMOURS AND COMPANY  
LEGAL PATENT RECORDS CENTER  
BARLEY MILL PLAZA 25/1128  
4417 LANCASTER PIKE  
WILMINGTON, DE 19805

EXAMINER
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SWITZER, JULIET CAROLINE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/326,285

Applicant(s)

SHEN, JENNIE BIH-JIEN

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

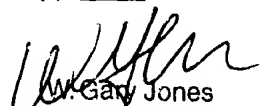
Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600

Continuation of 2. NOTE: The amendment to the claims significantly broadens the scope of the claims by amending the claims to recite that the isolated nucleic acid fragment within the chimeric gene may comprise the "all or part" of the complement of the isolated nucleic acid fragment that encodes a desaturase consisting essentially of SEQ ID NO: 9, or "all or part" of the complement of a nucleic acid comprising instant SEQ ID NO: 1. The "or part" portion of these recitations (present in all of the amended claims) significantly broadens the scope of the claims and examination of such claims would require further search and consideration.

Continuation of 5. does NOT place the application in condition for allowance because: The remarks are addressed insofar as they relate to the unamended claims, as the instant amendment will not be entered for the reasons discussed in (2).

The 112 2<sup>nd</sup> rejections are maintained because the amendment was not entered or considered. Applicant's arguments regarding these are directed towards the proposed amended claims.

The rejections under 112 1<sup>st</sup> paragraph are maintained.

Applicants argue that there is a clear correlation between structure and function because the claims recite that the fragment is a desaturase. However, while the claims recite that the fragment encodes a desaturase, the claims also encompass fragments of the fragment, which are not required to encode a desaturase. Furthermore, the claims do not recite that the desaturase be a desaturase which retains activity, and encompass mutants that are not active enzymes. All remaining arguments in this regard are directed towards the amended claims and are moot in view of the fact that the amendment was not entered.

Applicant's further arguments are directed towards the amended claims and are not considered as the amendments have not been entered.

It is noted that claims which REQUIRE a nucleic acid encoding a polypeptide comprising instant SEQ ID NO: 9, or the complement of such a nucleic acid (in its entirety) would be sufficient to overcome the art rejections of record.